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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,047	12/20/2000	Steve Okun	11271STUS01U	9953

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EXAMINER

MILLER, BRANDON J

ART UNIT

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2683

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*4*

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/742,047	<b>Applicant(s)</b> OKUN ET AL.
	<b>Examiner</b> Brandon J Miller	<b>Art Unit</b> 2683

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
   
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
   
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
   
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   
 - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_.
   
 2a) This action is FINAL.                    2b) This action is non-final.
   
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-24 is/are pending in the application.
   
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
   
 5) Claim(s) \_\_\_\_ is/are allowed.
   
 6) Claim(s) 1-24 is/are rejected.
   
 7) Claim(s) \_\_\_\_ is/are objected to.
   
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.
   
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
   
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.
   
     If approved, corrected drawings are required in reply to this Office action.
   
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   
 a) All    b) Some \* c) None of:
   
     1. Certified copies of the priority documents have been received.
   
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
   
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   
     \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
   
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 9-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow.

Regarding claim 1 Chow teaches a mobile switching center, comprising a processor; and an internal bus coupled to the processor (see col. 35, lines 60-65, col. 43, lines 13-15 and FIG. 12). Chow teaches a memory for storing computer instructions, which computer instructions define operational logic of the mobile switching center (see col. 17, lines 42-47 & 59-62, col. 43, lines 6-23 and FIG. 12) and more particularly, logic for receiving and responding to a request by a called party user of a mobile station for a message to be played to a calling party to advise the calling party that the called party will be taking the call shortly (see col. 34, lines 27-35 & 58-61).

Regarding claim 9 Chow teaches a system for connecting a calling party to a called party, comprising: circuitry including logic for receiving and interpreting a call request from a calling party (see col. 37, line 67 and col. 38, lines 14). Chow teaches logic for determining the identity of a communications node to which a call setup signal is to be routed as part of establishing a call between a called and calling parties (see col. 37, lines 45-67 and col. 38, lines 1-4). Chow teaches logic for responding to a select indication made upon a called party phone, which select indication is a request for a specified message to be played to a calling party to advise the calling party that the called party will be taking the call shortly (see col. 34, lines 27-35 & 58-61).

Regarding claim 10 Chow teaches logic for responding to a select indication that the called party is ready to take the call (see col. 41, lines 48-63).

Regarding claim 11 Chow teaches connecting the call upon received the select indication that the called party is ready to take the call (see col. 41, lines 48-63).

Regarding claim 12 Chow teaches a specified message to be played that is received in the form of DTMF tones (see col. 48, lines 39-40).

Regarding claim 15 Chow teaches logic to cause a call to be connected immediately after receiving a select indication that is a request for a specified message to be played to a calling party (see col. 41, lines 13-60).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8, 13-14, and 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Khasnabish.

Regarding claim 2 Chow teaches a device as recited in claim 1 except for instructions further defining logic to prompt a mobile switching center to prompt an IVR to play a specified message to the calling party. Chow does teach instructions further defining logic to prompt a mobile switching center to prompt the play of a specified message to the calling party (see col. 34, lines 27-35 & 58-61). Chow does not specifically teach an interactive voice response (IVR) to play a specified message. Khasnabish teaches using an IVR for specified messages in call holding features (see col. 6, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include an interactive voice response (IVR) to play a specified message because this would allow for first device to send a signal to a second device indicating a call has been placed on hold.

Regarding claim 3 Chow teaches logic to prompt the MSC to place a calling party on hold (see col. 34, lines 50-53).

Regarding claim 4 Chow teaches logic to prompt a MSC to place a calling party on hold until the MSC receives a ready indication from a called party (see col. 41, lines 48-53).

Regarding claim 5 Chow teaches logic to prompt a MSC to place a calling party on hold until a specified amount of time has elapsed (see col. 42, lines 17-21).

Regarding claim 6 Chow teaches a specified amount of time that is less than one minute (see col. 42, lines 17-21).

Regarding claim 7 Chow teaches a specified amount of time that is approximately equal to twenty seconds (see col. 42, lines 17-21).

Regarding claim 8 Chow teaches logic to complete a call setup and, as soon as the call is setup, prompting a specified message to be played (see col. 34, lines 50-61). Khasnabish teaches using an IVR for specified messages in call holding features (see col. 6, lines 60-67).

Regarding claim 13 Chow teaches a device as recited in claim 9 except for a message to be played is received in the form of a select DTMF tone, which select DTMF tone must be received within a specified time frame triggered by one of receiving an “off hook” indication or, in the case of a wireless network, a call acceptance indication. Chow does teach a message to be played which must be received within a specified time frame triggered by one of receiving a call acceptance indication (see col. 37, lines 43-51). Khasnabish teaches a select DTMF tone (see col. 4, lines 46-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a message to be played is received in the form of a select DTMF tone, which select DTMF tone must be received within a specified time frame triggered by one of receiving an “off hook” indication or, in the case of a wireless network, a call acceptance indication because this would allow for a first device to send a signal to a second device indicating a specific response.

Regarding claim 14 Chow teaches a device as recited in claim 9 except for a specified message to be played that is received in the form of a defined signal within a defined response signal. Khasnabish teaches a specified message to be played that is received in the form of a defined signal within a defined response signal (see col. 4, lines 53-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a specified message to be played that is received in the form of a defined signal

within a defined response signal because this would allow for a first device to send a signal to a second device indicating a specific response.

Regarding claim 16 Chow teaches a method for connecting a call placed by a calling party to a called party including receiving an indication that a call is to be setup with the called party and determining a serving node for the called party and transmitting call setup signals to the serving node (see col. 37, lines 45-66). Chow teaches receiving an indication of a called party number (see col. 5, lines 29-33). Chow also teaches responding to a called party response by triggering the play of a select message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 34, lines 50-61). Chow does not specifically teach an interactive voice response (IVR) to play a specified message. Khasnabish teaches using an IVR for specified messages in call holding features (see col. 6, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include an interactive voice response (IVR) to play a specified message because this would allow for first device to send a signal to a second device indicating a call has been placed on hold.

Regarding claim 17 Chow teaches connecting the call without waiting for a ready indication to connect the call (see col. 34, lines 66-67 and col. 35, lines 1-9).

Regarding claim 18 Chow teaches waiting for a ready indication transmitted by the called party phone prior to connecting the call (see col. 41, lines 13-19).

Regarding claim 19 Chow teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 20 Chow teaches a called party response including a request that is received in a specified period of time since the transmission of a call setup signal to a called party (see col. 37, lines 53). Chow does not teach a request in the form of a select DTMF tone. Khasnabish teaches a select DTMF tone (see col. 4, lines 46-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a request in the form of a select DTMF tone because this would allow for a first device to send a signal to a second device indicating a specific response.

Regarding claim 21 Chow teaches advising a calling party of a sequence of steps that a calling party may take to leave a message (see col. 42, lines 5-11 & 25-30).

Regarding claim 22 Chow teaches re-entering into an alert mode of operation (see col. 38, lines 5-8 and col. 39, lines 62-64).

Regarding claim 23 Chow teaches re-entering into an alert mode of operation that occurs only when activation by a calling party (see col. 38, lines 5-13).

Regarding claim 24 Chow teaches re-entering into an alert mode of operation that occurs automatically after the expiration of a specified amount of time (see col. 38, lines 5-8 and col. 39, lines 62-64).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gutzmann U.S Patent No. 6,118,861 discloses a calling party invoked held call monitoring.

Nakamura U.S Patent No. 6,553,221 discloses incoming call notification apparatus.

Nguyen U.S. Patent No. 5,995,848 discloses a system and method of completing calls to busy mobile subscribers in a radio telecommunications network.

Ahlberg U.S. Patent No. 5,657,372 discloses systems and methods for selectively accepting telephone calls without establishing voice communications.

Reichelt U.S. Patent No. 5,764,746 discloses holding party call back subscriber feature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



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